

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of)
SATOSHI KONO ET AL.)
U.S. PATENT NO. 5,465,635) Group Art Unit: 3502
Serial No. 08/243,526)
Filed: May 16, 1994) Examiner: V. Luong
Issued: November 14, 1995)
For: CRANKSHAFT ASSEMBLY FOR)
INTERNAL COMBUSTION ENGINE)

DECLARATION BY NONINVENTOR IN SUPPORT OF
REISSUE UNDER 37 CFR § 1.175(b)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Mr. T. Suzuki, hereby declare as follows:

1. I am associated with ISP Corporation of Tokyo, Japan, the applicants' Japanese representatives for the above-identified application.

2. I have been responsible for instructing the prosecution of U.S. Patent Application Serial No. 07/485,659, filed February 27, 1990, and U.S. Patent Application Serial No. 08/243,526, filed May 16, 1994, through a U.S. patent attorney, Ronald P. Kananen, since approximately late January, 1993.

3. This declaration will corroborate and support certain allegations made in the Reissue Declaration filed on April 9, 1996, in connection with the above-identified reissue application.

4. I believe the original patent to be partly or wholly inoperative because of error, without deceptive intention, by reason of the applicants claiming less than they had a right to claim in the patent.

5. I believe the errors which render the patent wholly or partly inoperative or invalid arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention on my part or on the part of the applicants.

6. On January 26, 1993, I received a letter from Mr. Kananen dated January 16, 1993, enclosing an Examiner's Answer mailed on January 13, 1993. The deadline for the appellant's reply brief was February 13, 1993.

7. On January 29, 1993, I sent a report on the Examiner's Answer to the patent & licensing department of the Assignee by facsimile. In this report of January 29, 1993, I first proposed additional claim limitations that were eventually

added to claim 11 (claim 1 of the '635 patent) in an amendment filed February 15, 1994. Specifically, the newly proposed claim limitations included the following limitation:

wherein each of said elastic plate, said flywheel body and said reinforcing member comprises a first portion, said first portion of said flywheel body being placed axially between said first portions of said elastic plate and said reinforcing member, and said first portion of said flywheel body being axially movable between said first portions of said elastic plate and said reinforcing member.

This proposed limitation is the origin of the similar limitations contained in each of Claims 1, 8 and 9 of the issued '635 patent. At this point, I was completely unaware of the flywheel structures shown in Figs. A and B, and this proposed amendment was only intended to cover all of the illustrated embodiments disclosed in the '635 patent.

8. On February 4, 1993, I received a facsimile letter from the Assignee's patent & licensing department approving the proposed amendment sent January 29, 1993, together with a copy of Japanese Utility Model Provisional Publications Nos. 1-67352 and 63-190639.

9. On February 5, 1993, I sent by facsimile a further proposal to the Assignee's patent & licensing department (a copy of this facsimile is attached as Exhibit 1). This further

proposal contained the proposed amendment to claim 11, as well as newly proposed claims 19 to 26 for possible inclusion in a continuation application. I also sent a facsimile letter on March 26, 1993 requesting Mr. Kananen to await a decision on the pending appeal before pursuing a continuation application.

10. On January 24, 1994, I received a facsimile letter dated January 23, 1994 from Mr. Kananen regarding the Board's decision. On January 25, 1994, I sent a report on the Board's decision to the Assignee by facsimile, and also proposed to file the claims that were previously proposed by me on February 5, 1993.

11. On January 28, 1994, I received a facsimile letter from the Assignee approving the filing of the proposed claims.

12. On February 3, 1994, I sent the proposed amendments to claim 11 and new claims 19 to 26 to Mr. Kananen. On February 15, 1994, I received a facsimile letter from Mr. Kananen confirming the filing of an Amendment and an Information Disclosure Statement in the U.S. PTO. On March 3, 1994, I reported Mr. Kananen's facsimile of February 15, 1994 to the Assignee.

13. On January 17, 1995, I received a letter dated January 5, 1995 from Mr. Kananen regarding an Office Action mailed December 27, 1994. On January 23, 1995, I sent a report to the Assignee regarding the Office Action of December 27, 1994 (a copy of this report is attached as Exhibit 2). This report contained my proposed amendment to the claims, which amendments were eventually made by an amendment filed on March 27, 1995. On February 7, 1995, I received written approval from the Assignee of the proposed amendments. On February 14, 1995, I sent a proposed amendment to Mr. Kananen, which amendment was filed by Mr. Kananen on March 27, 1995.

14. On September 7, 1995, I received a facsimile communication from the Assignee requesting that the claims of the '526 application be broadened to cover the structure shown in the attached Figs. A and B. I did not receive a copy of the attached Figs. A and B until September 12, 1995.

15. Due to administrative oversight, my office did not bring the insufficiencies in the allowed claims to the attention of Mr. Kananen until December 5, 1995, approximately three weeks after issuance of the '635 patent. At that time, a decision was made to seek reissue of the '635 patent to correct the insufficiencies in the claims.

16. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Wherefore, I hereby subscribe my name to the foregoing Declaration.

Date: February 28, 1997



T. Suzuki
ISP Corporation